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NOT FOR CITATION

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

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7 EDWIN LYDA,

8 Plaintiff,

9 v.

10 CBS INTERACTIVE, INC.,

11 Defendant.

Case No. [16-cv-06592-JSW](#)

**ORDER GRANTING MOTION TO
DISMISS, WITH PREJUDICE, AND
DENYING REQUEST FOR
ATTORNEYS' FEES AND SANCTIONS
WITHOUT PREJUDICE**

Re: Dkt. No. 16

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Now before the Court for consideration is the motion to dismiss filed by CBS Interactive, Inc. (“Defendant”). The Court has considered the parties’ papers, relevant legal authority, the record in this case, and it found the motion suitable for disposition without oral argument. *See* N.D. Civ. L.R. 7-1(b). For the reasons set forth herein, the Court GRANTS Defendant’s motion to dismiss, with prejudice.

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BACKGROUND

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In 2014, Plaintiff filed a complaint, which he subsequently amended, against Defendant and CBS Corporation (“CBS”) in the United States District Court for the Southern District of New York. In that case, Plaintiff alleged Defendant and CBS infringed United States Patent No. 7,434,243, Response Apparatus Method and System (the ““243 Patent”) and United States Patent No. 7,730,506, Method and Apparatus for Response System (the ““506 Patent”) (“*Lyda I*”). (*See* Dkt. No. 1, Compl. ¶ 9; Dkt. No. 16-1, Declaration of Ehsun Forghany (“Forghany Decl.”), ¶¶ 2-3, Ex. 1 (*Lyda I* Complaint), Ex. 2 (*Lyda I* Amended Complaint).)

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On July 16, 2015, the *Lyda I* court dismissed the amended complaint for failure to state a claim, and it denied Plaintiff leave to file a second amended complaint. (Forghany Decl., ¶ 4, Ex. 3 (Opinion and Order at 6-9).) The United States Court of Appeals for the Federal Circuit

1 affirmed. *See Lyda v. CBS Corporation*, 838 F.3d 1331 (Fed. Cir. 2016) (“*Lyda I*”).¹

2 On November 14, 2016, Plaintiff filed his Complaint in this action, in which he asserts
3 four claims for relief against Defendant based on alleged infringement of the ’243 Patent and the
4 ’506 Patent. Plaintiff’s allegations of infringement in this case, as in *Lyda I*, are premised on
5 voting by the viewing audience of the television show “Big Brother.”

6 According to the patents, audience members of game shows or
7 reality programs often use input devices to electronically vote in
8 response to cues during the shows. In particular, the ’243 and ’506
9 patents cover methods and systems for obtaining real time responses
a broadcast to respond to the broadcast in real time without requiring
a personal computer.

10 *Lyda I*, 838 F.3d at 1334.

11 Plaintiff alleges that *Lyda I* put Defendant on notice of claim 8 of the ’243 Patent and
12 claim 1 of the ’506 Patent. Plaintiff alleges that, notwithstanding that notice, Defendant continued
13 to broadcast Big Brother, including permitting voting by the audience, and thereby induced
14 infringement “of the aforementioned patents by conducting most of the steps of method claims
15 and inducing the television audience to become direct infringers.” (Compl. ¶¶ 9-10, 15-16, 19-
16 20.)

17 ANALYSIS

18 A. Applicable Legal Standard.

19 Defendant moves to dismiss pursuant to Federal Rule of Civil Procedure 12(b)(6). Under
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21 ¹ The issues presented to the Federal Circuit were whether Plaintiff’s complaint satisfied the
22 pleading requirements set forth in Form 18 of the Appendix of Forms, which accompanied, now
23 abrogated, Federal Rule of Civil Procedure 84. The Federal Circuit also considered whether
24 claims of joint infringement should be measured by the pleading requirements set forth in Form 18
25 or whether they should be judged by the pleading standards set forth in *Bell Atlantic Corp. v.*
Twombly, 550 U.S. 544 (2006) and *Ashcroft v. Iqbal*, 556 U.S. 662 (2009). *Lyda I*, 838 F.3d at
1338-39. The court held that, as with claims for induced or contributory infringement, claims of
joint infringement should be governed by the *Twombly* and *Iqbal* standards. *Id.* at 1339.

26 Plaintiff agreed at oral argument that he was proceeding against CBS and Defendant on a
27 “joint infringement theory of direct infringement,” and the Federal Circuit also concluded that
each of Plaintiff’s claims “implicates joint infringement.” It then found that Plaintiffs’ allegations
28 were not sufficient under *Twombly* and *Iqbal* and affirmed the district court’s decision to dismiss
the case with prejudice. *Id.* at 1339-41.

1 Rule 12(b)(6), the Court’s “inquiry is limited to the allegations in the complaint, which are
2 accepted as true and construed in the light most favorable to the plaintiff.” *Lazy Y Ranch LTD v.*
3 *Behrens*, 546 F.3d 580, 588 (9th Cir. 2008). Even under the liberal pleadings standard of Federal
4 Rule of Civil Procedure 8(a)(2), “a plaintiff’s obligation to provide the ‘grounds’ of his
5 ‘entitle[ment] to relief’ requires more than labels and conclusions, and a formulaic recitation of the
6 elements of a claim for relief will not do.” *Twombly*, 550 U.S. at 555 (citing *Papasan v. Allain*,
7 478 U.S. 265, 286 (1986)). Pursuant to *Twombly*, a plaintiff must not allege conduct that is
8 conceivable but must allege “enough facts to state a claim to relief that is plausible on its face.”
9 *Id.* at 570. “A claim has facial plausibility when the Plaintiff pleads factual content that allows the
10 court to draw the reasonable inference that the Defendant is liable for the misconduct alleged.”
11 *Iqbal*, 556 U.S. at 678 (citing *Twombly*, 550 U.S. at 556). “Ordinarily affirmative defenses may
12 not be raised by motion to dismiss, ... but this is not true when, as here, the defense raises no
13 disputed issues of fact.” *Scott v. Kuhlmann*, 746 F.2d 1377, 1378 (9th Cir. 1984) (citations
14 omitted).

15 As a general rule, “a district court may not consider any material beyond the pleadings in
16 ruling on a Rule 12(b)(6) motion.” *Branch v. Tunnell*, 14 F.3d 449, 453 (9th Cir. 1994), *overruled*
17 *on other grounds by Galbraith v. County of Santa Clara*, 307 F.3d 1119 (9th Cir. 2002) (citation
18 omitted). However, the Court may consider documents attached to the complaint, documents
19 relied upon but not attached to the complaint, when the authenticity of those documents is not
20 questioned, and other matters of which the Court can take judicial notice, without converting a
21 motion to dismiss into a motion for summary judgment. *Zucco Partners LLC v. Digimarc Corp.*,
22 552 F.3d 981, 990 (9th Cir. 2009).²

23 If the allegations are insufficient to state a claim, a court should grant leave to amend,
24 unless amendment would be futile. *See, e.g. Reddy v. Litton Indus., Inc.*, 912 F.2d 291, 296 (9th
25 Cir. 1990); *Cook, Perkiss & Liehe, Inc. v. N. Cal. Collection Serv., Inc.*, 911 F.2d 242, 246-47 (9th
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27 ² Defendant requests that the Court take judicial notice of the pleadings and orders filed in
28 connection with *Lyda I*. Plaintiff has not objected to Defendant’s request. Because the Court may
take judicial notice of the existence of those documents, it grants Defendant’s request. *See, e.g.,*
Lee v. City of Los Angeles, 250 F.3d 668, 689-90 (9th Cir. 2001); Fed. R. Evid. 201.

1 Cir. 1990).

2 **B. Plaintiff's Claims Are Barred by the Doctrine of Res Judicata.**

3 Defendant argues Plaintiff's claims are barred by res judicata, because they could have
4 been raised in *Lyda I*. “Res judicata, also known as claim preclusion, bars litigation in a
5 subsequent action of any claims that were raised or could have been raised in the prior action.”
6 *Owens v. Kaiser Foundation Health Plan, Inc.*, 244 F.3d 708, 713 (9th Cir. 2001) (citation
7 omitted). The doctrine of res judicata and collateral estoppel “is a rule of fundamental and
8 substantial justice, of policy and of private peace, which should be cordially regarded and enforced
9 by courts.” *Federated Dep’t Stores, Inc. v. Moitie*, 452 U.S. 394, 401 (1981).

10 The Ninth Circuit's test to determine whether the doctrine of res judicata applies is “well-
11 established.” *Mpoyo v. Litton Electro-Optical Sys.*, 430 F.3d 985, 987 (9th Cir. 2005); *see also*
12 *Accumed v. Stryker Corp.*, 525 F.3d 1319, 1323 (Fed. Cir. 2008) (“To the extent that a case turns
13 on general principles of claim preclusion, as opposed to a rule of law having special application to
14 patent cases, this court applies the law of the regional circuit in which the district court sits[.]”).
15 The Court considers whether ““the earlier suit ... (1) involved the same ‘claim’ or cause of action
16 as the later suit, (2) reached a final judgment on the merits, and (3) involved identical parties or
17 privies.”” *Mpoyo*, 430 F.3d at 987 (quoting *Sidhu v. Flecto Co.*, 279 F.3d 896, 900 (9th Cir.
18 2002)).

19 Plaintiff does not dispute that *Lyda I* reached a final judgment on the merits or that it
20 involved identical parties. Thus, the only issue is whether Plaintiff raised or could have raised
21 these claims in *Lyda I*. The Court analyzes this issue under Federal Circuit law. *See Accumed*,
22 525 F.3d at 1323. The Federal Circuit is guided by the approach set forth in the Restatement
23 (Second) of Judgments, by which “a claim is defined by the transactional facts from which it
24 arises.” *Id.* It is undisputed that *Lyda I* involved the same patents and Plaintiff alleged Defendant
25 infringed at least some of the same patent claims at issue in this case. In addition, Plaintiff's
26 claims of infringement in *Lyda I* also are based on the voting procedures used in connection with
27 Big Brother. (*See, e.g.*, *Lyda I* Amended Complaint ¶¶ 6-8.) Plaintiff's current theory of liability
28 is that Defendant induced infringement of the '243 and '506 Patents. *See* 35 U.S.C. § 271(b)

1 (“Whoever actively induces infringement of a patent shall be liable as an infringer.”).

2 In order “[t]o establish liability under section 271(b), a patent holder must prove that once
3 the defendants knew of the patent, they actively and knowingly aided and abetted another’s direct
4 infringement.” *DSU Medical Corp. v. JMS Co. Ltd.*, 471 F.3d 1293, 1305 (Fed. Cir. 2006)
5 (internal quotations and brackets omitted). Plaintiff argues he could not have asserted these claims
6 in *Lyda I*, because Defendant “was unaware of the patents-in-suit, and [Defendant] was incapable
7 of knowingly inducing infringement without such knowledge.” (Opp. Br. at 6:11-13.)

8 Plaintiff has not provided the Court with any authority to suggest that he was legally
9 precluded from asserting Defendant induced infringement in *Lyda I*. The Federal Circuit has not
10 directly addressed this issue.³ However, courts have permitted claims based on induced
11 infringement to go forward without pre-suit knowledge of a patent and have limited recovery to
12 post-suit conduct. *See, e.g., Windy City Innovations LLC v. Microsoft Corp.*, 193 F. Supp. 3d
13 1109, 1115-16 (N.D. Cal. 2016); *CAP Co., Ltd. v. McAfee, Inc.*, Nos. 14-cv-05068-JD, 14-cv-
14 05071-JD, 2015 WL 3945875, at *4-5 (N.D. Cal. June 26, 2015); *Bascom Research LLC v.*
15 *Facebook, Inc.*, Nos. 12-cv-6293-SI through 12-cv-6297-SI, 2013 WL 968210, at *3-4 (N.D. Cal.
16 Mar. 12, 2013); *cf. Script Security Solutions, LLC v. Amazon.com, Inc.*, 170 F. Supp. 3d 928, 937
17 (E.D. Tex. 2015) (citing cases and noting majority view permits claims for induced infringement
18 based on filing of lawsuit to establish knowledge); *Rembrandt Social Media LP v. Facebook, Inc.*,
19 950 F. Supp. 2d 876, 882 (E.D. Va. 2013) (noting split in district courts, but that majority view
20 finds that “post-suit knowledge (i.e., knowledge provided by the filing of the lawsuit) satisfies the
21 knowledge element for indirect infringement,” and that consequence is a patent holder “may only
22 recover damages for indirect infringement for the period of time that commences once the putative
23 infringer learns of the patent”). In light of the lack of guidance from the Federal Circuit and the
24 split in authority, Plaintiff had at least a colorable basis to allege the knowledge element of a claim

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26 ³ In *In re Bill of Lading Transmission and Processing System Patent Litigation*, on which
27 Defendant relies, the Federal Circuit found that the plaintiff sufficiently alleged claims for induced
28 infringement. 681 F.3d 1323, 1345-45 (Fed. Cir. 2012). In at least two of the complaints, the
plaintiff relied on the complaint to allege the defendant knew of the patent. *Id.* The court did not,
however, directly hold that a complaint is sufficient to show a defendant has the requisite
knowledge of a patent for purposes of induced infringement.

1 for induced infringement based on the filing of the complaint.

2 The Court's conclusion that Plaintiff's claims are barred is further supported by the fact
3 Plaintiff's argument that Defendant was not aware of the patents-in-suit before he filed *Lyda I* is
4 not supported by the record. In *Lyda I*, in order to support an allegation of willful infringement,
5 Plaintiff alleged that “[o]n or about July 7, 2011, Defendant CBS Interactive was provided with
6 the notice sent to Defendant CBS pointing out the patents-in-suit and informed that its activities
7 were infringing the ‘243 and ‘506 Patents.” Plaintiff also alleged that Defendant was a willful
8 infringer because “it continued its infringing activities after being informed that those activities
9 were infringing the patents-in-suit.” (*Lyda I* Complaint ¶ 69.) Plaintiff reasserted those
10 allegations in his amended complaint. (*Lyda I* Amended Complaint ¶ 71.)

11 Defendant also has submitted the letter referenced in the *Lyda I* Complaint as an exhibit.
12 (Dkt. No. 22-2, Supplemental Declaration of Ehsun Forghany, ¶ 2, Ex. 7 (letter dated July 11,
13 2011.) Although the letter is sparse on details, Plaintiff stated that “at least claims 1 and 9 of the
14 ‘243 patent and at least claims 1 and 7 of the ‘506 patent are being infringed by the text of
15 selections offered to the [Big Brother] audience.” (*Id.*) Defendant acknowledged that it received
16 the letter on July 28, 2011, and stated that it had “obtained copies of the patents and reviewed each
17 of the claims of both” patents-in-suit. (*Id.*, ¶ 3, Ex. 8.)

18 The Court finds that the facts alleged in this case arise from the same set of transactional
19 facts that gave rise to *Lyda I*. In addition, Plaintiff has not demonstrated that he was precluded
20 from asserting claims of induced infringement, and the facts show he could have raised such
21 claims in *Lyda I*.

22 Accordingly, the Court finds Plaintiff's claims are barred by the doctrine of *res judicata*.⁴

23 **C. The Court Denies, Without Prejudice, Defendant's Request for Attorney's Fees and
24 Sanctions.**

25 Defendant has moved the Court for an award of attorneys' fees, on the basis that the case
26 qualifies as an “exceptional” case under 35 U.S.C. section 285. In the alternative, Defendant seeks

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28 ⁴ In light of this ruling, the Court does not reach Defendant's alternative argument regarding
the sufficiency of the pleadings.

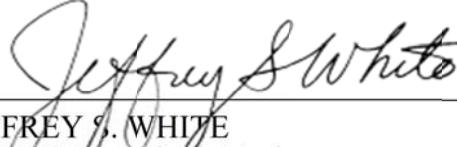
1 sanctions under 28 U.S.C. section 1927. The Court denies those requests, without prejudice. The
2 Court's ruling is without prejudice to Defendant filing a properly noticed motion for fees and/or
3 sanctions, within fourteen days after entry of judgment. *See* Fed. R. Civ. P. 54(d); N.D. L.R. 7-
4 8(d). If Defendant moves for fees and costs under both Section 285 and Section 1972, it shall
5 address the legal authority and standards supporting a request for fees and costs under both
6 statutes. In addition, Defendant shall support any such motion with declarations and documentary
7 evidence that sets forth the fees and costs it seeks to recover.

8 **CONCLUSION**

9 For the foregoing reasons, the Court GRANTS Defendant's motion to dismiss. Because
10 leave to amend would be futile, the Court dismisses this case with prejudice. The Court shall issue
11 a separate judgment, and the Clerk shall close this file.

12 **IT IS SO ORDERED.**

13 Dated: March 1, 2017

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JEFFREY S. WHITE
United States District Judge

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